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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,166	09/14/2000	Thomas John Bitove	T8-465969CIP:DDH	9770

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CANADA

EXAMINER

BARNIE, REXFORD N

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 04/23/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.  
09/662,166

Applicant(s)  
Bitove et al.

Examiner  
REXFORD BARNIE

Art Unit  
2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 27, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7-10 and 15-37 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-10 and 15-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

REXFORD BARNIE  
PRIMARY EXAMINER

04/10/03

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DETAILED ACTION

*Claim Rejections - 35 U.S.C. § 112*

1. Regarding claims 15, 24, 31, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

*Claim Rejections - 35 U.S.C. § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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3. Claims 7-10 and 15-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woynoski et al. (US Pat# 6,370,240) in view of Muehlberger et al. (US Pat# 5,696,908).

Regarding claims 7 and 15, Woynoski teaches an ATM system in (see column 2 lines 48-50) wherein a user can purchase a prepaid account wherein the ATM functions just like the conventional ATM machine in conjunction with a financial institution without having to contact a telephone service provider (see col. 2 lines 58-67). Further, Woynoski teaches that a user can purchase a prepaid account with any desired amount in (see col. 4 lines 22-27). A printing means can print a receipt with an account identifier. Note that there would be a plurality of PINS to be used by a plurality of subscribers as means of accessing prepaid telecommunication services. Woynoski fails to teach being able to select a desired service provider associated with a purchased card.

Muehlberger teaches a telephone debit card dispenser and method wherein a user can purchase a prepaid account by using one of a plurality of payment methods including cash, bank card or credit card in (see col. 1 lines 6-10). Furthermore, Muehlberger teaches that a user can select a desired prepaid account amount in addition to a desired service provider in (see column 4 lines 60-67, column 5 lines 13-17). According to Muehlberger, the card can be issued by a bank thus removing the need to contact a telephone carrier during a card issuing process in (see col. 6 lines 9-12 and col. 7 lines 25-37).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to give a user the option to purchase a prepaid account as desired thus being

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able to phone calls away from home and also, to reduce telephone expenses, an advantage known and associated with prepaid telephone cards.

Regarding claims 7-10, see the explanation as set forth in the rejection of claim 7 in addition to the fact that the combination teaches the possibility of being able to use a bank card such as taught by Woynoski or in (see col. 1 lines 6-10 of Muehlberger et al.) Wherein a use can use one of a plurality of options including cash, credit card or bank card in acquiring a prepaid account. The combination including Woynoski would obviously teaches an interface of an ATM machine through which a user can interact with the system or according to Muehlberger in (see col. 5). The credit card can be authenticated by a clearinghouse. The combination teaches being able to validate a prepaid account based on a unique PIN, giving a user the option to purchase a desired card with varying amounts and from a desired service provider.

Regarding claims 16-17 and 25-26, The combination teaches the possibility of being able to use a bank card such as taught by Woynoski or in (see col. 1 lines 6-10 of Muehlberger et al.) Wherein a use can use one of a plurality of options including cash, credit card or bank card in acquiring a prepaid account.

Regarding claim 18, The combination including Woynoski would obviously teaches an interface of an ATM machine through which a user can interact with the system or according to Muehlberger in (see col. 5). The credit card can be authenticated by a clearinghouse

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Regarding claims 19-23, The combination teaches being able to validate a prepaid account based on a unique PIN, giving a user the option to purchase a desired card with varying amounts and from a desired service provider.

Regarding claim 24, see the explanation as set forth in the rejection of claim 15-23.

Regarding claims 27-30, The combination including Woynoski would obviously teaches an interface of an ATM machine through which a user can interact with the system or according to Muehlberger in (see col. 5). The credit card can be authenticated by a clearinghouse. The combination teaches being able to validate a prepaid account based on a unique PIN, giving a user the option to purchase a desired card with varying amounts and from a desired service provider.

4. Claims 31-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woynoski et al. (US Pat# 6,370,240) in view of Muehlberger et al. (US Pat# 5,696,908) and further in view of Fougnes et al. (US Pat# 5,722,067).

Regarding claims 31, see the explanation as set forth in the rejection of claim 1 in addition to the fact that the account can be used for prepaid telephony services. The combination fails to teach the ability of being able to associate a telephone number or ANI with a prepaid account.

Fougnes teaches a security telecommunications system wherein the ANI associated with a wireless terminal could be used as means of triggering a pre-paid account when a call is made through a network (see column 3 line 37-column 4 line 34, column 6).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of ordinary skill in the art at the time the invention was made to incorporate the teaching of Fougny into that of Clark thus making it possible to make prepaid telephone calls without having to dial the account number but be able to do so based on simply the received ANI associated with the telephone which saves a user the time and effort to make the call.

Regarding claim 32-35, The combination including Woynoski would obviously teaches an interface of an ATM machine through which a user can interact with the system or according to Muehlberger in (see col. 5). The credit card can be authenticated by a clearinghouse. The combination teaches being able to validate a prepaid account based on a unique PIN, giving a user the option to purchase a desired card with varying amounts and from a desired service provider.

Regarding claims 36-37, The examiner takes official notice that it's notoriously well known in the mobile communication art to assign cell phone certain frequencies to operate by using TDMA, CDMA and so forth. Also, well known is the assignment of MINS and ESNs to wireless telephones for identification and billing purposes.

#### *Conclusion*

5. Any inquiry concerning this communication or earlier communication from the examiner should be directed to REXFORD BARNIE whose telephone number is (703) 306-2744. The examiner can normally be reached on Monday through Friday from 8:30 to 6:00p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached on (703) 305-4708.

Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to (703) 872-9314 and labeled accordingly (Please label

**"PROPOSED/INFORMAL" or "FORMAL"**).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 306-0377.

Rexford Barnie

Patent Examiner

04/10/03

*R. Barnie*  
**REXFORD BARNIE**  
**PRIMARY EXAMINER**